

REMARKS

1. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the amendments and discussion that follows. Claims 1-30 are pending in this application.

The drawings have been objected to. The specification has been objected to. The claims have been objected to. Claims 7-13, 20-26 and 30 have been rejected under 35 U.S.C. §112, first paragraph. Claims 1-30 have been rejected under 35 U.S.C. §102(b) as being anticipated by or under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 4,560,161 to Hamano. After a careful review of the claims (as amended), it has been concluded that the rejections are improper and the rejections are, therefore, traversed.

2. The drawings have been objected to. In particular, the Examiner asserts that "the [means for] displaying indicia of a winning combination of items present within the plurality of items in advance of selection . . . must be shown". However, the "winning . . . combination may be provided within the display 70 (e.g., 'TWO OF A KIND', FULL HOUSE', etc.)" (specification, par. [0042]). As such, one means for displaying the winning combination may be a portion of the BIG GAME display 70 shown in FIG. 12 and is also shown in FIG. 2 with the reference number 48. Since this element is shown, the objection is improper and should be withdrawn.

The Examiner asserts next that "[means for] displaying the indicia . . . randomly selecting . . . selected items (clm 13, 26) . . . as claimed, must be shown". However, as demonstrated above, the means for displaying the indicia is described in the specification [par. 0042] and is shown in

FIGs. 2 and 12 with reference numbers 48 and 70. One illustrated means for "randomly selecting" is described in paragraph [0043] and is shown in FIG. 2. The means for displaying the selected items are shown in FIGs. 5-12. Similarly, the second display area is shown in FIGs. 5-12. The means for displaying the winning criteria is shown in FIG. 12 and is designated by the reference number 70. The means for displaying the non-selected items is clearly the display area 60.

The Examiner asserts next that "[means for] displaying the indicia . . . second display area . . . a winning criteria . . . non-selected items (clm 30), as claimed, must be shown". The second display area is shown in FIGs. 5-12. The winning criteria is shown in FIG. 9.

The steps of claims 1-13 are shown in new FIG. 13.

The Examiner asserts next with regard to the rejection that "This . . . is an objection grounded in public policy that the claimed invention be illustrated for the illiterate to comprehend the invention" (Office Action of 5/17/04, page 2). However, illiteracy is not the standard. The standard is that of the understanding of one of average skill in the art. If the Examiner believes that the standard is that of illiteracy, then the Examiner is respectfully requested to provide a basis for this assertion or withdraw the objection.

3. The specification has been objected to. In particular, the Examiner asserts that "The specification is objected to as failing to provide antecedent basis for . . . [means for] grouping (claims 6, 10), [means for] displaying a name of only a relatively highest level winning combination (claim 12, 25), [means for] displaying

the indicia of the possible winning combination further comprises [means for] randomly selecting the winning combination (claims 13, 26) and second display area . . . a winning criteria . . . non-selected items (clm 30)" (Office Action of 5/17/04, page 2).

In this regard, paragraph [0018] has been amended to describe the step of and means for grouping. Paragraph [0019] has been amended to recite a "means for displaying a name (indicia) of only a relatively highest level winning combination". Paragraph [0043] has been amended to state that "the display 70 may display the highest relative value or name of the winning hand". Paragraph [0043] already recites the use of one illustrated device (i.e., CPU 42) for randomly selecting the winning hand to be displayed. Paragraphs [0018] and [0043] have been amended to recite the second display area and winning criteria.

4. Claims 7-13, 20-26 and 30 have been rejected under 35 U.S.C. §112, first paragraph. In this regard, the Examiner asserts that "the specification . . . does not reasonably provide enablement for the displaying comprising the randomly selecting function/structure in that it is not taught/disclosed that the selection is part of the displaying" (Office Action of 5/17/04, page 3). As may be best understood from the Examiner's comments, it appears that the Examiner has failed to thoroughly review the specification with regard to operation of the CPU 42. In this regard, paragraph [0043] clearly describes the process of random selection and display.

The Examiner asserts next that "the specification . . . does not teach or suggest that a selection of winning combination is conducted by the machine since it merely

states that a statistical minimum number of items is provided to assure at the last one winning combination and no discussion that the items are randomly selected to achieve a predetermined win rank" (Office Action of 5/17/04, pages 3-4). However, the Examiner would also appear to be mistaken in this regard, since paragraph [0043] clearly states that it is the CPU 42 selects the winning hand from the winning hands present within the subset. In addition, the statistical minimum number of items would appear to be irrelevant to the issue of randomly selecting winning combinations of hands that are already present within the subset.

The Examiner asserts next that "the specification . . . does not reasonably provide enablement for second display comprising winning criteria" (Office Action of 5/17/04, page 4). However, the Examiner would appear to be mistaken since the winning criteria is clearly shown in FIG. 9.

It is noted next that the Examiner's speculation with regard to what a person of skill in the art would understand from the specification does not provide a sufficient basis for rejection under 35 U.S.C. §112. More specifically, "a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirements of the first paragraph of §112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied upon for enabling support". In re Marzocchi & Horton, 169 USPQ 367 (CCPA 1971). The specification clearly teaches the manner and process of making and using the invention in terms which

correspond in scope to those used in describing and defining the subject matter sought to be patented. Further, the Examiner has failed to provide any teaching which provides a basis for doubting the objective truth of any statement within the specification.

Since the Examiner has failed to establish any basis for doubting the objective truth of the specification, it is believed that the rejection is in error. Since the rejection is in error, the rejection should be reversed.

5. Claims 1-30 have been rejected as being anticipated by or as being obvious over Hamano. In response, independent claims 1, 14 and 27 have been further limited to the context where the items are cards. Support for this additional limitation may be found throughout the specification (e.g., par. [0029].

Independent claims 1, 14 and 27 have also been limited to a subset of a deck of 52 cards. Support for this additional limitation may be found in paragraph [0030].

Independent claims 1, 14 and 27 have also been further limited to the context where the subset of cards "has a minimum number of cards that is certain to contain at least one winning combination of the plurality of winning combinations". Support for this limitation may be found in paragraph [0029].

In contrast, Hamano fails to provide any teaching or suggestion of the use of a subset of cards. In addition, the display of winning hands in the entire deck (as under Hamano) is different than the claimed invention, which is limited to the display of winning combinations that are actually present within the subset.

In addition, Hamano fails to provide any teaching or

suggestion regarding the use of a "minimum number of cards that is statistically certain to contain at least one winning combination". New claims 31-33 are explicitly drawn to the specific feature where for poker, the statistically minimum number is thirteen.

For any of the above reasons, Hamano fails to teach or suggest each and every claim limitation. Since Hamano fails to teach or suggest each and every claim element, the rejection is believed to be improper and should be withdrawn.

6. Allowance of claims 1-33, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

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